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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,088	11/14/2001	Jeffrey L. Trudeau	004608.00003	8571
22908	7590	02/05/2004	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			PRIDDY, MICHAEL B	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 02/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/994,088	<b>Applicant(s)</b> TRUDEAU ET AL.	
	<b>Examiner</b> Michael B Priddy	<b>Art Unit</b> 3732	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-55 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2,3,12,14-17,25-28,30-34,41,42,44-49 and 51-54 is/are allowed.
- 6) ☐ Claim(s) 1,5-11,13,18-24,29,35-40,43 and 50 is/are rejected.
- 7) ☐ Claim(s) 4 and 55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 1, 13, 29 and 49 contain the language "a clamping surface adaptive to receive a tensioning tool". This language is not present in the specification. Applicant has referred to page 7, paragraph 27, line 2 as containing support for this language however, the Examiner believes the element Applicant is referring to is either "clamp barrel 118" or "annular recess 119".

### ***Claim Objections***

Claim 55 is objected to because of the following informalities: in line 1, "and" should be --an--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5-11, 13, 18-24, 29, 35-40 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandreid (U.S. 5,083,350). Sandreid teaches a clamp for clamping an elongate member 20 comprising: a housing 10 for receiving the elongate member 20, a saddle member 16 (means for engaging the elongate member in at least

two positions) movably mounted relative to the housing 10; a platen 17 (means for engaging a substantial periphery of the elongate member) movably mounted relative to the housing 10; a lever 31 cooperating with the platen 17 for moving the saddle member 16 and platen 17 relative to the housing 10; and an engaging surface 18/19 for engaging the elongate member 20; wherein the lever 31 (means for selectively moving the platen and saddle member relative to the housing) is pivotably attached to the saddle member in a slot 34, the slot 34 being formed in the saddle member 16 and having at least two distinct positions (ends) allowing the lever 31 to pivot from at least two positions (one position shown in solid lines and the other in broken lines); wherein engaging surfaces 18/19 are associated with both the platen 17 and the saddle member 16 for engaging the member 20; wherein a portion of a lengthwise cross-section of the engaging surface is non-linear. Sandreid further teaches a barrel-shaped clamping surface 21 adapted to receive a tensioning tool.

Concerning the language “integrated into” of claims 5-7, 19-21 and 35-37, the Examiner has interpreted this to be equivalent to “integral with”. “Integral is sufficiently broad to embrace constructions united by such means as fastening and welding.” *—In re Hotte* (CCPA) 177 USPQ 326. The Examiner contends that since the engaging surface, housing, saddle and platen of Sandreid are fastened together, they may be considered integral with (integrated into) on another. Considering the language “engage at least a portion of a periphery”, it is the Examiner’s belief that the engaging surfaces of Sandreid, while having tooth-like formations that may penetrate the

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periphery of the member 20, must engage some portion of the periphery at least around the point of penetration.

Claim 50 is rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al. (U.S. 5,312,410). Miller et al. teaches a method of clamping an elongate member in a medical device, as set forth in lines 45-68 of column 5 and lines 1-68 of column 6, comprising in combination the steps of: inserting an end of the elongate member 4 through the body 20 of a cable tensioner and clamping device housing; applying a clamping force to the elongate member using the clamping device and in so doing, engaging a periphery of the elongate member 4; and using the cable tensioner to apply tension to the elongate member 4.

#### ***Allowable Subject Matter***

Claim 55 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2, 3, 12, 14-17, 25-28, 30-34, 41, 42, 44-49 and 51-54 are allowed.

#### ***Response to Amendment***

In the complete listing of claims, Applicant has indicated that claim 50 is "withdrawn". It is unclear what Applicant intends by this indication since the claim has

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not been explicitly canceled or withdrawn from consideration as a result of a restriction requirement. Clarification is requested.

### ***Response to Arguments***

Applicant's arguments filed 11/07/2003 have been fully considered but they are not persuasive. Applicant has argued that Sandried et al. does not teach the "clamping surface adaptive to receive a tensioning tool" added to claims 1, 13, 29 and 49. The Examiner believes the above rejection under 35 USC 102(b) sufficiently addresses this argument.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

*Michael B. Priddy*  
January 28, 2004

*Kevin Shaver*  
KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700